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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/629,759

07/30/2003

Glenn Roy

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01/05/2010

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EXAMINER

STULII, VERA

ART UNIT

PAPER NUMBER

1794

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/629,759	<b>Applicant(s)</b> ROY ET AL.	
	<b>Examiner</b> VERA STULII	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,10-13,15-21,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10-13,15-21,24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-7, 10-11, 15-17, 19-21, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akihiko et al (JP 2001323263) for the reasons as stated in the Non-Final Office action mailed 07/09/2009.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akihiko et al (JP 2001323263) in view of COFFEE (COFFEE: RELATED BEVERAGES) for the reasons as stated in the Non-Final Office action mailed 07/09/2009.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akihiko et al (JP 2001323263) in view Taguchi et al (JP 2002138024).

Claim 18 has been amended to exclude dandelion and hawthorn extract from the list of the botanical extracts.

Akihiko et al is taken as cited above. Akihiko et al do not disclose use of botanical extracts other than coffee bean extract. Taguchi et al disclose hair dye composition comprising the following botanical extracts Rubia akane, turmeric, sappanwood, cork tree, Sophora japonica, cochineal, chestnut, onion and/or coffee (Abstract). Since Akihiko et al disclose pigment fading inhibitor comprising coffee bean extract as an active ingredient, and since Taguchi et al discloses coffee extract or chestnut extract as a part of a stable dyeing composition, one of the ordinary skill in the art would have been motivated to substitute coffee extract with chestnut extract, since

Taguchi et al discloses that coffee and chestnut extracts are functional equivalents in the stable dyeing composition comprising various coloring botanical extracts.

***Response to Arguments***

Applicant's arguments filed 10/02/2009 in response to the Office action mailed 07/09/2009 have been fully considered but they are not persuasive.

On page 8 of the Reply to the Non-Final Office action mailed 07/09/2009 filed 10/02/2009, Applicants state that "the Office Action considers that Akihiko teaches the "concept of preventing color fading using botanically derived color stabilizers." Applicant respectfully disagrees that Akihiko teaches such broad concepts. Rather, as admitted on page 5 of the Office Action, Akihiko teaches only a method for inhibiting the fading of natural pigments using a coffee bean extract as an active ingredient (fading inhibitor)". In response to this argument it is noted that, Akihiko teaches a method for inhibiting the fading of natural pigments using a coffee bean extract, therefore coffee bean extract is a botanically derived color stabilizer, and thus Akihiko teaches preventing color fading using botanically derived color stabilizers, such as coffee extract.

In regard to Applicants' arguments that Akihiko et al do not disclosed synthetic colors as recited in claims 1, 20 and 21 (pages 8-9 of the Reply to the office action mailed 03/21/2008). Akihiko et al do not disclose colors/pigments as currently recited. However, as disclosed by applicant and understood in the art, each of the originally claimed synthetic colors would be a functional equivalent known in the art. Color additives as taught by Akihiko et al and recited by applicant were known to be added or applied to a food, drug or cosmetic, are capable of imparting color. These color

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additives were used in foods for the reasons of offsetting color loss due to exposure to light, air, temperature extremes, moisture and storage conditions; correcting natural variations in color; enhancing colors that occur naturally; etc. Since color additives as recited and taught by Akihiko et al are functional equivalents known for the same purpose, it would have been obvious to substitute one for another. It would also have been obvious to substitute one color additive for another based on expectation of similar functions and similar positive results. The concept of preventing color fading using botanically derived color stabilizers is taught by Akihiko et al and therefore is shown to be known. Substitution of one color additive with another for the same purpose would not impart any patentable distinction. Regarding “*synthetic* color” limitation, Akihiko et al disclose industrial riboflavin preparation (p.3 [0014]). In any case, the concept of preventing color fading using botanically derived color stabilizers is taught by Akihiko et al and therefore is shown to be known. Akihiko et al recognizes the problem of color fading, and teaches the solution of the problem, i.e. preventing color fading using botanically derived color stabilizers. One of ordinary skill in the art would have been motivated to employ teachings of Akihiko et al and to solve the same problem (color fading) by applying known solution as disclosed by Akihiko et al (preventing color fading using botanically derived color stabilizers).

In response to Applicants’ arguments regarding color additives as functional equivalents, it is noted that color additives as taught by Akihiko et al and recited by applicant were known to be added or applied to a food, drug or cosmetic, are capable of imparting color. These color additives were used in foods for the reasons of offsetting

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color loss due to exposure to light, air, temperature extremes, moisture and storage conditions; correcting natural variations in color; enhancing colors that occur naturally; etc. The color additives either synthetic or natural are used for their coloring function and therefore are considered to be functional equivalents.

In response to Applicants arguments regarding claims 12 and 13, it is noted that on pages 6-7 of Specification Applicants state that "In other preferred embodiments, the C6-C3 phenylpropenoic carbonyl compound is selected from cinnamoyl esters, coumarins, chalcones, flavones, chromones, isoflavones, and combinations thereof and may optionally be provided in the form of an extract of a botanical selected from horse chestnut extract, dandelion extract, eucalyptus extract, stringybark extract, saw palmetto extract, honeysuckle extract, hawthorn extract, noni fruit extract, red clover extract, orange extract, buckwheat extract, chamomile extract and combinations thereof" [0021]. Since Akihiko et al disclose pigment fading inhibitor comprising coffee bean extract as an active ingredient, and since dandelion root and hawthorn were well known coffee substitutes, one of the ordinary skill in the art would have been motivated to substitute one coffee material with another coffee material (dandelion or hawthorn), since beans, dandelion root and hawthorn were well known coffee substitutes. Since COFFEE discloses dandelion root extract and hawthorn extract, it also meets limitations of claims 12 and 13 according to Applicants' disclosure.

Applicant's arguments with respect to claim 18 have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vera Stulii/  
Examiner, Art Unit 1794

/KEITH HENDRICKS/  
Supervisory Patent Examiner, Art Unit 1794